

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2623**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Christian BERTIN et al.

Group Art Unit: 2623

Application No.: 10/765,448

Examiner: O. IDOWU

Filed: January 27, 2004

Docket No.: 127524

For: TOPIC-ORIENTED METHOD OF RECORDING DIGITAL CONTENTS
BROADCAST IN ACCORDANCE WITH A SCHEDULE

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the July 11, 2007 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-16 are pending in this application. In view of at least the following, reconsideration and allowance are respectfully requested.

I. Claim Rejections under 35 U.S.C. § 103

The Office Action rejects claims 1-5 and 8-16 under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0078817 (Horowitz) in view of U.S. Patent Application Publication No. 2002/0127000 (Yamato); and rejects claims 6-7 under 35 U.S.C. § 103(a) Horowitz in view of Yamato, and further in view of U.S. Patent No. 6,996,627 (Carden). These rejections are respectfully traversed.

The Office Action asserts that Horowitz teaches the presently claimed combination of features recited in independent claim 1, except a preliminary step of the access terminal selecting a set of contents having a common topic. However, to cure such a deficiency, the Office Action relies on Yamato. Applicants respectfully disagree with the Office Action's interpretation of the applied reference Horowitz. As discussed below, the combination of Horowitz and Yamato fails to teach, disclose or suggest the combination of features presently recited in claim 1.

Independent claim 1 recites, in part, "a step of the audiovisual content presentation server selecting an audiovisual content to be recorded, on the basis of the selected set, the content being associated with a broadcast date and time predetermined by the content broadcaster."

In other words, pursuant to the presently claimed combination of features recited in independent claim 1, claim 1 recites, in part, that steps of selecting audiovisual contents to be recorded is executed by the presentation server. Indeed, the information associated with the audiovisual contents to be broadcast are stored in the audiovisual content presentation server and not in the access terminal. Support for such a position may be found, for example, at page 5, lines 20-22, which states that "the presentation server offers users of the Internet pages presenting audiovisual contents to be broadcast by the broadcaster." Therefore, the selection of the contents to record is made directly on the presentation server which thereafter generates a record file for the access terminal.

Deficiencies of Horowitz

In contrast to the presently claimed combination of features, pursuant to the disclosure of Horowitz, the steps of selecting an audiovisual content to be recorded are executed by the access terminal. Indeed, the electronic program guide (EPG) is stored in the memory of the client's device (see paragraph 18 of Horowitz) after having been transmitted from the program

data provider 104: "the published version of the program data can be transmitted from program data provider via a satellite directly to a client's device by use of a satellite 10" (see paragraph 43 of Horowitz).

Consequently, the selection of the content to be recorded by the access terminal is made directly from the EPG stored in the access terminal. For example, paragraph 18 of Horowitz states that "the recording application is configured, when executed on the processor, to receive a request to record a program recognized by the EPG."

As a result, Horowitz does not disclose a step of the audiovisual content presentation server selecting an audiovisual content to be recorded because, pursuant to the teachings of Horowitz, the selection is made by the access terminal.

Additionally, the Office Action concedes at page 3 of the Office Action, that Horowitz does not disclose a step of selecting, from an access terminal, a set of contents having a common topic offered by an audiovisual content presentation server.

Deficiencies of Yamato

Pursuant to the disclosure of Yamato, the information associated with the audiovisual content to be broadcast is stored inside the access terminal and not in a distant server. For example, paragraph 136 of Yamato states that "data of the EPG are sent with data of a program via a cable television network." Further, paragraph 138 of Yamato states that "the program recording device 80 receives and stores the data of the EPG."

Consequently, in contrast to the presently claimed combination of features, according to Yamato the selection from the access terminal of a set of contents having a common topic, for example, a user's favorite programs, is executed inside the access terminal and not by a distant audiovisual content presentation server. For example, paragraph 167 of Yamato states that "[i]n conventional program recording devices which use data of the EPG, there are some program recording devices which search the data of the EPG for user's favorite programs by

using keywords or types which are established in advance by the user, extracts the searched programs, and automatically records the extracted programs."

Combination of Horowitz and Yamato

Even if Horowitz and Yamato could be combined, Applicants respectfully submit that such a combination fails to teach, disclose or suggest the presently claimed combination of features. For example, neither Horowitz nor Yamato disclose a step of an audiovisual content presentation server selecting an audiovisual contents to be recorded.

Consequently, because of the deficiencies of Horowitz and Yamato, the combination of the applied references could not lead the ordinary artisan to further add a step of the audiovisual content presentation server selecting audiovisual contents to be recorded. Such a step is not otherwise anticipated by the applied reference of record or rendered obvious by any combination of the applied references of record.

Rather, even if a person of ordinary skill were to combine Horowitz with Yamato, such a combination of the applied references would only result in a method that includes the following steps:

- (1) a preliminary step of a content server transmitting information concerning the contents to be broadcast to all the access terminal (i.e., allegedly taught by Horowitz)
- (2) a step of an access terminal selecting user's favorite programs (i.e., allegedly taught by Yamato)
- (3) a step of the access terminal generating a record file containing information identifying the selected audiovisual content (i.e., allegedly taught by Horowitz); and
- (4) a step of updating the record file (i.e., allegedly taught by Horowitz).

Clearly, such a resultant method is different form the presently claimed combination of features. Therefore, the combination of Horowitz and Yamato would not have led a person of ordinary skill in the art, to the presently claimed invention.

One of the many advantages the presently claimed combination of features offers and a motivating factor for combining such features is the reduction in the flow of information transmitted between the presentation server and the access terminal. The presently claimed combination of features addresses this problem by transferring the step of selecting the information to record from the access terminal to the presentation terminal. In contrast to reducing the flow of information transmitted between a presentation server and the access terminal, Horowitz attempts to address the problem by selecting the content information to be transmitted or otherwise compressing the information to be transmitted (see paragraph 43 of Horowitz). Thus, because Horowitz attempts to address the problem in another fashion, one of ordinary skill in the art at the time of the invention would lack the proper motivation to combine the applied references.

Carden

Carden does not otherwise cure the deficiencies inherent in the combination of Horowitz and Yamato with regards to at least independent claim 1.

Summary

Thus, Horowitz, Yamato, and Carden, in any combination, do not teach, disclose or suggest "a step of the audiovisual content presentation server generating a record file containing information identifying the selected audiovisual content to be recorded and the scheduled date and time for broadcasting the selected audiovisual content." Therefore Horowitz, Yamato, and Carden, either individually or in combination, do not teach, disclose or suggest the subject matter recited in claim 1.

Claims 2-15 depend from claim 1. Because the applied references, in any combination, fail to render the subject matter of independent claim 1 obvious, dependent claims 2-15 are patentable for at least the reasons that claim 1 is patentable, as well as for the additional features they recite.

Accordingly, withdrawal of the rejections is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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